

Application No. 10/517,290
Reply to Office Action of May 30, 2006

KIT 377-US (10415624)

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REMARKS

In light of the above-amendments and remarks to follow, reconsideration and allowance of this application are requested.

Claims 1 and 5 have been amended, and claims 10-14 have been added. Accordingly, claims 1-14 are presented for consideration. Claim 1 has been amended to recite that the rare earth compound is uniformly mixed in the wall member and support for such recitation is found in paragraphs 16 and 48 in the specification.

New claim 10 recites that the wall member is formed by charging and installing the wall forming material containing the rare earth compound in advance at a location where said wall member is to be formed. Support for such recitation is found in paragraph 59 in the specification.

New claims 11-14 depends from new claim 10 and recites substantially subject matter recited in claims 2-4 and 6, respectfully.

Applicant acknowledges with appreciation that Examiner finds claims 2 and 7 allowable if rewritten independent form.

Claim 5 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant as the invention. Claim 5 has been amended to depend now from claim 4, thereby providing sufficient antecedent basis for the limitation "said grain material." Accordingly, applicant respectfully requests that this rejection to claim 5 be withdrawn.

Claims 1, 3, 4, 6, 8 and 9 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent 6,357,968 issued to Dwyer et al. (Dwyer) in view of anticipated by JP2001-200236A. Claim 5 has been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dwyer and JP2001-200236A in view of U.S. Patent 6,699,321 issued to Pelot et al. (Pelot). Applicant respectfully traverses these rejections.

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Applicant respectfully submit that only the present invention teaches or suggests a wall member formed of wall forming material containing a uniformly mixed rare earth compound carried therein, as required by amended claim 1. This enables the wall member of the present invention to reliably partition between the polluted soil side and non-polluted soil, thereby providing uniform pollutant absorbing performance across the wall member.

Dwyer describes constructing a underground barrier wall structure using a jet grout injector subassembly. Dwyer indicates that at least four secondary nozzles should be utilized to construct the underground barrier wall having uniform thickness. However, Dwyer does not teach or suggest a wall member formed of wall forming material "containing a uniformly mixed rare earth compound carried therein," as required by amended claim 1. In fact, Dwyer clearly states that he is addressing the "problem of weakness and non-uniform thickness cause by the bow-tie shaped associated with jet grout injection using conventional dual-nozzle technology" (col. 3, lines 12-14).

JP2001-200236A describes using an arsenic insolubilizing treatment agent for arsenic contaminant, but not describe the process of such treatment nor does it teach or suggest a wall member formed of wall forming material "containing a uniformly mixed rare earth compound carried therein," as required by amended claim 1.

Of course, to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. Here, the Examiner has failed to establish a *prima facie* case of

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obviousness because neither Dwyer nor JP2001-200236A teach or suggest a wall member formed of wall forming material "containing a uniformly mixed rare earth compound carried therein," as required by amended claim 1 and thus included in dependent claims 2-14. Applicant respectfully submits that the Examiner has failed to establish the basic requirements of a *prima facie* case of obviousness for claims 1-20.

Additionally, the Examiner has failed to establish a *prima facie* case of obviousness because there is no motivation in Dwyer or in JP2001-200236A that the teaching of these two references should be combined. Dwyer and JP2001-200236A fail to suggest the desirability of the claimed invention because it is undeniable that neither Dwyer nor JP2001-200236A is even remotely concerned with the problem of providing a wall member formed of wall forming material containing a uniformly mixed rare earth compound carried therein. "[T]he mere fact that the prior art can be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989) (quoting In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984)). Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 1-14.

Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by either Dwyer or JP2001-200236A, the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". Id. at 1962. See also, In re Rinehart, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem of providing a wall member formed of wall forming material containing a uniformly mixed rare earth compound carried therein was even recognized by the prior art, there can be no finding that the invention as a whole

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would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), "an inventive contribution can reside as well in the recognition of a problem as in a solution". It further appears that the conclusion reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that "[a]ppellant having discovered the source of the problem and solved the same . . . he is . . . entitled to patent protection". Id. at 121.

Absent applicant's disclosure, there appears to be absolutely no reason to add JP2001-200236A to Dwyer, especially since these two references are concerned with completely different problems. In fact, the only reason one might turn to JP2001-200236A, if at all, is because of the hindsight gleaned from applicant's own disclosure. The Federal Circuit has been consistent in warning against hindsight reconstruction of the prior art. As pointed out in Uniroyal v. Redkin-Wiley, 5 U.S.P.Q. 2d, 1434, 1438 (Fed. Cir. 1988):

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ...Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination."

* * *

"...it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In Uniroyal, the CAFC referred to Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Company, 221 U.S.P.Q. at 489, to conclude that "the mere fact that a device or process utilizes a known scientific principal does not alone make that device or process obvious." 5 U.S.P.Q. 2d at 1440.

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In Orthopedic Equipment Company, Inc. v. United States, 217 U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned,

"The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

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In reversing an Examiner's rejection based upon obviousness, wherein the Examiner concluded that a claimed apparatus is shown simply by turning a prior art reference "upside down," the CAFC ruled:

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), and citations noted therein.

In view of the foregoing, it is respectfully submitted that one of ordinary skill in the art, after reading and understanding Dwyer, would not even turn to JP2001-200236A – and if she did, she would not understand how or why Dwyer's description of using additional secondary nozzles to provide uniform wall thickness should be combined with the description of using an arsenic insolubilizing treatment agent for arsenic contaminant in JP2001-200236A.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. KIT 369-US (10403280) from which the undersigned is authorized to draw.

Dated: August 25, 2006

Respectfully submitted,



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